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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/822,509
Filing Date: April 12, 2004
Appellant(s): GOBIN ET AL.

Phouphanomketh Ditthavong
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on **05.28.2010** appealing from the Office action mailed **12.09.2009**.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

21-29. Claims 21-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Barry et al.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 6,615,258

Barry et al.

9-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 26 is rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

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process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, ***insignificant extra-solution activity*** will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or computing, is not sufficient to pass the test.

Examiner determines that the claim constitutes insignificant extra-solution activity because the step(s) constitute mere data transmission or recordation. Accordingly, **claim 26** remains unpatentable under 35 U.S.C. 101 because the insignificant extra-solution steps, for example: "generating a response message containing the invoice document based on the retrieved invoice data; and forwarding the response message to the host for display for the invoice document via a downloadable program ..., and etc." are incapable of imparting patent-eligibility under § 101. (For further guidance see also the USPTO Memorandum "Guidance for examining Process Claims in view of *In re Bilski*" dated 7 January 2009).

Examiner suggests including some type of machine or apparatus in the insignificant extra-solution steps.

Dependent claims 27-30 do not correct the above deficiencies and based on their dependency on **claims 26**, are likewise rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Barry et al. [US 6,615,258].

As per claims 21, 26, 31, and 36, Barry discloses a plurality of interfaces configured to communicate with a plurality of billing systems to retrieve invoice data [as illustrated in figure 25, which is a data flow diagram for various **transactions communicated** in the system].

- a conversion module configured to compress the invoice data for storage in a database and to create key information for retrieving the compressed invoice data within the database [see at least column 46: lines 8-15 (e.g. **When data is available from**

these billing systems, the online invoicing server typically performs a conversion process and stores the converted data on tape until an audit approval));

- an invoice processing module configured to receive a request message from a host for an invoice document [see at least column 46: lines 30-45 (e.g. ***The client component of the online invoicing includes a client interface for the user to select what data to retrieve. The data is then retrieved through various application processing, and a list of invoices and reports are provided for the user to choose from for online viewing***)]], to access the database for retrieval of invoice data corresponding to the invoice document in response to the request message [as illustrated in figure 7 (e.g. ***a process running in a OE client application process 154 sends transaction request messages via the infrastructure***)];

- communicating with a plurality of billing systems to retrieve invoice data [see summary of the invention (e.g. ***separate client applications may communicate with one another and with the backplane unit***)]; converting, in a processor, the retrieved invoice data by compressing the invoice data for storage in a database and creating key information for retrieving the compressed invoice data within the database [as indicated at steps 630 and 632, via the ***DSS IAIO*** reads the header to determine which Data Mart will ultimately be queried. It then parses the metadata into a format which the COTS software can readily ***convert into a SQL query, as indicated at step 635, FIG. 13(b)***]; accessing the database for retrieval of invoice data corresponding to the invoice document in response to the request message [see summary of the invention (e.g. a

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Web-based invoice reporting system allowing the customers **access to their billing and invoice reports** associated with services provided to a customer)];

- generate a response message containing the invoice document based on the retrieved invoice data [see at least paragraph bridging columns 19 and 20 (e.g. **Another object may be invoked to format the data into a response message and return the "get application list" request message is initiated at the client application**)], the response message being forward to the host for display of the invoice document via a downloadable program [as illustrated in figure 5 and via **step 1362 to display an online invoice screen** at the customer workstation)];

- forwarding the response message to the host for display of the invoice document via a downloadable program [see at least column 8: lines 39-55 (e.g. **As illustrated in FIG. 2, after one of the DMZ Web servers 24 decrypts and verifies the user session, it forwards the message through a firewall 25b over a TCP/IP connection 23 to the dispatch server 26 on a new TCP socket while the original socket 22 from the browser is blocking, waiting for a response**)].

As per claims 22-25, 27-30, and 30-35, Barry discloses wherein the host receives the response message via a web browser, the downloadable program being executed within the web browser [see at least column 6: lines 34-39 (e.g. **report applications using a Web browser paradigm**)];

- wherein the downloadable program is platform independent with respect to the host [see at least column 2: lines 47-55 (e.g. **The popularity of the public Internet provides a measure of platform independence for the customer, as the customer**

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can run their own Internet Web-browser and utilize their own platform connection to the Internet to enable service));

- wherein the host supports selecting figures presented in the invoice document for performing an arithmetic operation on the selected figures [with reference to figure 56, ***the online invoicing server 1350 stores documents from various billing systems and performs the various database queries and function calls in response to requests received from the customer via the online invoicing proxy 1340. Particularly, the online invoicing server 1350 is responsible for tasks including data collection, calculation, storage, and report generation));***

- wherein the host populates a products and date range field associated with a user identifier [see at least column 15: lines 36-42 (e.g. ***All access to the suite of applications is controlled by user identifiers (userids) and passwords***)], the products and date range field listing application services and time periods for which the invoice document is available for presentation [as illustrated in figure 22, ***a flow diagram illustrating an online invoicing back-end server process flow when responding to client requests for document presentation***)];

- wherein the host receives the response message via a web browser, the downloadable program being executed within the web browser [as illustrated in figure 1, ***a diagrammatic illustration of the software architecture component in which the present invention functions. A first or client tier 10 of software services are resident on a customer workstation 10 and provides customer access to the enterprise system, having one or more downloadable application objects directed***

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to front-end business logic, one or more backplane service objects for managing sessions, one or more presentation services objects for the presentation of customer options and customer requested data in a browser recognizable format and a customer supplied browser for presentation of customer options and data to the customer and for communications over the public Internet)];

- wherein the downloadable program is platform independent with respect to the host [see at least column 7: lines 14-20 (e.g. ***The customer workstation includes client software capable of providing a platform-independent, browser-based, consistent user interface implementing objects programmed to provide a reusable and common GUI abstraction and problem-domain abstractions***)].

As per claims 37-39, Barry discloses: receiving the response message over a secure communication session of a packet switched [as reference in figure 2, it is understood that each Intranet server of suite 30 communicates with one or several consolidated databases which include each customer's data management information. For example, the Services Inquiry server 36 includes communication with the enterprise's Customer Service Management legacy platform 40(a). Such network management and customer network data is additionally accessible by authorized management personnel. As shown in FIG. 2, other legacy platforms, e.g. 40(d), may also communicate individually with the Intranet servers for servicing specific transactions initiated at the client browser. The illustrated legacy platforms 40(a)];

- wherein the downloadable program is platform independent [see at least column 7: lines 14-20 (e.g. ***The customer workstation includes client software capable of providing a platform-independent, browser-based, consistent user interface implementing objects programmed to provide a reusable and common GUI abstraction and problem-domain abstractions***)];

- highlighting figures on the image of the invoice document; and performing an arithmetic operation of the highlighted figures [with reference to figure 56, ***the online invoicing server 1350 stores documents from various billing systems and performs the various database queries and function calls in response to requests received from the customer via the online invoicing proxy 1340. Particularly, the online invoicing server 1350 is responsible for tasks including data collection, calculation, storage, and report generation***)].

(10) Response to Argument

Appellant argues that Barry does not disclose the features in claims 26 and 31. The Examiner respectfully disagrees. Barry discloses a Web-based, integrated customer interface system for data management. The customer interface system is provided with a graphical user interface for enabling a user to interact with one or more services provided by remote servers located in an Intranet/Extranet of an enterprise providing products and services, and utilizes a Web paradigm to allow easy and convenient access to all of the services from the user's perspective [see abstract].

Barry further discloses that the data management products and services delivered to a client workstation having the integrated customer interface include: 1)

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report requester, report viewer, and report management applications enabling a customer to request, specify, customize and schedule delivery of reports pertaining to customer's data; 2) centralized inbox system for providing on-line reporting, presentation, and notifications to a client workstation from one or more Intranet application services over an Internet/Intranet network; 3) an operational data storage system implementing a data mart approach for maintaining the data used for customer reporting; 4) a trouble ticket tool enabling a customer to open and monitor trouble tickets relating to products and services provided by an enterprise; 5) a Web-based invoice reporting system allowing the customers access to their billing and invoice reports associated with services provided to a customer; 6) an Internet "online" order entry and administration service to enable customers to manage their accounts; and, 7) a system for handling security and authentication requests from both client and server side of the applications implementing the suite of data management products and services [see summary of the invention].

Appellant also argues that Barry does not disclose any calculations performed on figures selected from the invoice document. The Examiner respectfully disagrees. Barry discloses via the **Report Manager 250** includes and provides access to the metadata which is used to tell the Report Requestor what a standard report should look like and the "pick-list" options the user has in order for them to customize the standard report. It is used to tell the Report Viewer client how to display the report, what **calculations or translations** need to be performed at the time of display, and what further customization options the user has while viewing the report.

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Appellant further argues that Barry does not disclose highlighting figures on an image of an invoice document and performing an arithmetic operation on those highlighted figures. The Examiner respectfully disagrees. Barry's report viewer application 215 will also be able to accept messages telling it to display an image or text that may be passed by one of the applications in lieu of report data (e.g., Invoice, etc.). Barry also discloses that arithmetic operation can be performed via the online invoicing server 1350.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Garcia Ade/

Examiner, Art Unit 3687

/Matthew S Gart/

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